

REMARKS

The foregoing amendment and these remarks are respectfully submitted in response to the Office Action of June 1, 2005 and are believed to overcome all of the rejections and objections set forth therein.

Claims 1-43 are currently pending in the application. However, claims 10, 11, 13, 26, 28, and 29 have been withdrawn from further consideration pursuant to a restriction requirement.

Claims 40-43 have been allowed.

Claims 15-18 and 34-36 have been found allowable, but objected to as being dependent upon a rejected base claim.

Claims 1-3, 5-9, 12, 14, 20-25, 27, and 37-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson, U.S. Patent No. 4,365,710 ("Swanson"), paragraphs [0002] and [0003] of Applicant's specification and a new cited reference, U.S. Patent No. 5,895,540 to David ("David"). Additionally, claims 4 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson, paragraphs [0002] and [0003] of Applicant's specification, David, and Fujiwara, U.S. Patent No. 5,722,584 ("Fujiwara"). Claims 30-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson, paragraphs [0002] and [0003] of Applicant's specification, David and Winski, U.S. Patent No. 5,269,645 ("Winski").

In addition, Claims 1-9, 12, 14-25, 27, and 29-39 stand rejected in the Office Action under 35 U.S.C. § 112, first paragraph, based on the position that the specification lacks support for positioning the first singular cartons *en masse*.

After reviewing the Office Action and the cited references, Applicant has amended the application to more clearly set forth the present invention. In light of this amendment and the reasons explained more fully below, Applicant respectfully traverses the Office Action's rejection and requests reconsideration.

I. Brief Summary of the Claimed Invention

The claimed invention relates to a method of simultaneously making a plurality of composite cartons on a common assembly surface. In the claimed method, a plurality of cartons are placed on top of each other on a common assembly surface, such as a pallet, in such a way that (1) individual cartons are adhered only to corresponding individual cartons that comprise a

composite carton, and (2) all of the joined singular cartons in each composite carton remain joined together when the composite carton is removed from the assembly surface by lifting one of the singular cartons.

II. The Cited References

Newly cited in the Office Action is U.S. Patent No. 5,895,540 to David (“David”). As is the case with the previously cited Swanson and Winski references, the newly-cited David reference *does not even disclose a method of making a carton*, let alone a method of making a composite carton. Rather, like Swanson and Winski, the David reference discloses a method for adding stability (or “unitizing”) a pallet loaded with boxes. In David, each carton in vertical alignment on the pallet is adhered together and end-adjacent cartons in the same layer on the pallet are adhered to each other. Significantly the David reference teaches that the adhesive used should hold the boxes together while on a pallet, but should allow the boxes to be easily separated from each other. (See, e.g., col. 4, ll. 7-14).

With respect to the previously cited references, Applicant makes the following observations, which are particularly significant in light of the amended claims:

- In Swanson, adhesive is applied *to each carton on the pallet* (see col. 2, ll. 37-45) and the glue applied must allow for each carton to be pulled apart from the adjoining carton to which it is adhered *when unloading the pallet*. (see col. 2, ll. 37-45).
- In Winski, a spacing sheet is used between each layer of items stacked on a pallet. (col. 7, ll. 44-68). The bottom surface of this spacing sheet is tacky and serves to bond *all items in a layer together*.
- In Fujiwara, there is no disclosure of a composite carton but rather the disclosed invention is a display carton in which a portion of the carton blank (the “longitudinal cutout partition flap 8”) forms a “cross-shaped partition wall” when the display carton is assembled. (see Fig 4A, item 8).

Thus, none of the cited references disclose, teach or suggest Applicant’s method of making a composite carton in which (1) individual cartons on a pallet are adhered only to other individual cartons that make up a composite carton and (2) individual cartons in each composite carton

remained joined together when the uppermost individual carton in the composite carton is removed from the pallet.

III. Unitizing a Pallet Load is Fundamentally Different than Building Composite Cartons on a Pallet

As a threshold matter, Applicant notes that the cited Swanson, David and Winski references relate methods for “unitizing” or stabilizing a load of boxes on a pallet. The problem addressed by these references is (1) how to connect, directly or indirectly, all boxes on a pallet together such that all the connected boxes act like a single (i.e., “unitary”) load in order to stabilize the pallet when it is handled, and (2) how to do so in such a way that each individual box on the pallet does not remain connected to any other box on the pallet when removed from the pallet.

This is a fundamentally different problem than is addressed by Applicant’s claimed invention. In Applicant’s invention, individual cartons on the pallet are adhered not to all other cartons on the pallet but only to the other carton or cartons that make up a composite carton and, importantly, when a carton is removed from the pallet in Applicant’s invention, that carton remains adhered to at least one other carton.

The Office Action reflects some confusion regarding the nature of Applicant’s invention by asserting on Page 4 that “it would have been obvious [to combine references] in order to eliminate wrapping and ensure unitizing of the cartons.” (underline added). Applicant’s invention is not a process for unitizing a patent; it is a process of making composite cartons on a pallet.

It is simply not logical that one of ordinary skill in the art seeking to build a composite carton out of two or three individual cartons would look to references teaching that (1) all cartons on a pallet should be connected together, and (2) each carton should be removable from the pallet individually.

In Applicant’s view, the Office Action has not given due regard to the fact that in Applicant’s invention each first singular carton in the plurality of first singular cartons remains joined to a corresponding second singular carton in the plurality of second singular cartons when

the corresponding second singular carton is lifted from the assembly surface. All of the cited “unitizing” references teach the exact opposite. Because the cited Swanson, David and Winski references all teach away from Applicant’s claimed invention, they may not properly be combined to render the claimed invention obvious. M.P.E.P. § 2145.

IV. The Rejections Under 35 U.S.C. §112

Applicant respectfully disagrees with the Office Action’s position that there is no support in the present application for positioning the first singular cartons *in masse*, for two reasons. First, the present application has always included claims (20-25) in which a layer of first singular cartons are positioned on the assembly surface. Since “en masse” means “all together”, positioning a layer of individual cartons certainly describes the positioning of such cartons *en masse*. Second, it is simply not permissible for the Office Action to take the position that “Swanson and David appear to place the cartons en masse” (page 9) when rejecting Applicant’s claims and then take the exact opposite position when evaluating Applicant’s application under 35 U.S.C. §112. Indeed, the disclosure (including the drawings) in the present application have far more disclosure in this regard than do either Swanson or David. If Swanson and David are deemed by the Office Action as disclosing *en masse* carton positioning, then the present application should be treated consistently with such determination.

Nonetheless, Applicant has amended the claims of the present application to remove the term “en masse” as it relates to positioning of the first singular cartons. In light of this amendment, Applicant respectfully submits that the rejections under 35 U.S.C. 112 have been overcome.

V. Traversal of Official Notice

Applicant traverses the official notice set forth in the Office Action that is well known to optimize the separation force of adhered cartons, for several reasons. First and most importantly, this position is not supportable in situations where, as in the claimed invention, individual cartons are first adhered together sufficiently so that the composite carton is capable of remaining adhered and then later the individual cartons in the composite carton are separated without destroying the structural integrity of each of the individual cartons. Second, the

separation force required for a particular composite carton is necessarily related to the materials of which the individual cartons are made, the adhesive used and the products contained within each such carton. These many variables mean that it cannot be "well known" as a general proposition to optimize the claimed separation range without regard for such variables.

VI. The Present Invention is Patentable over the Cited References

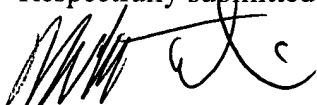
Applicant submits that the legal positions discussed in Applicant's previous response remain valid. In the interest of brevity, Applicant does not include that discussion in this response. Nonetheless, Applicant requests reconsideration of Applicant's previous discussion in light of the amended claims contained herein.

In addition, Applicant notes that the cited references lack any teaching of the following aspects of Applicant's claimed invention:

- a method of making a composite carton;
- a method in which each individual carton on the pallet is adhered only to other cartons that will remain joined to it when removed from the pallet;
- a method of simultaneously positioning a layer of cartons adjacent to another layer of cartons to which adhesive has been applied; and
- a method of making composite cartons in which the individual cartons in each composite carton constructed on a pallet remain adhered together when removed from the pallet.

Given the lack of any teaching of these aspects of the claimed invention and the fact that the cited references teach away from the claimed invention, Applicant respectfully requests allowance of the present application. Should there be any questions regarding this application, the Examiner is invited to contact the undersigned at the number shown below.

Respectfully submitted,



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